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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,988	02/17/2004	Gerrit Konijn	TS1194 (US)	1334
23632	7590	09/20/2006	EXAMINER	
SHELL OIL COMPANY P O BOX 2463 HOUSTON, TX 772522463			BUSHEY, CHARLES S	
			ART UNIT	PAPER NUMBER

1724

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/779,988

Applicant(s)

KONIJN, GERRIT

Examiner

Scott Bushey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8-7-06.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by DE 38 32 420 A1 (Fig. 1).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 4, and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 38 32 420 A1 taken together with EPO 0 048 508 A2.

DE 38 32 420 A1 (Fig. 1) as applied above substantially discloses applicant's invention as recited by instant claims 3, 4, and 6-8, except for the at least one opening formed in the sidewall of the tubular conduit of the primary separation device and the return skirt being integrally formed with the upper wall.

EPO 0 048 508 A2 (Figs. 6 and 7) disclose a primary separation device having a tubular conduit, wherein at least one opening (67) is formed in the sidewall thereof. The reference also teaches forming the return skirt (72) around the tubular conduit as being

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integral with the upper wall of the separation tray. It would have been obvious for an artisan at the time of the invention, to modify the apparatus as taught by DE 38 32 420 A1, to include at least one opening in the sidewall of the tubular conduit, and to form the return skirt integrally with the upper wall, in view of EPO 0 048 508 A2, since such would reduce the pressure drop within the primary separation device by allowing more exit area for the liquid enriched fluid from the tubular conduit, and forming the return skirt integrally with the upper wall would lend structural integrity to the upper wall.

5. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference combination as applied to claims 3, 4, and 6-8 above, and further in view of Sheinman.

The reference combination as applied to claims 3, 4, and 6-8 above substantially discloses applicant's invention as recited by instant claims 9-14, except for the specific recitation that the swirl imparting means are formed integrally with the bottom wall and are formed by providing the metal plate of the bottom wall with slits and then bending the segments out of the plane of the plate. While silent to the manner of forming the swirl vanes, the references of the reference combination as applied to claims 3, 4, and 6-8 above almost certainly form the vanes from a metal sheet or plate. Furthermore, applicant must recognize that the manner of manufacture of the swirl means is irrelevant to the patentability of the apparatus claim, if the reference(s) teach(es) the same structure. Therefore, the sequence of steps of claim 9, as well as the cutting step being a laser cutting step, as recited by instant claim 11, cannot be considered to impart

patentability to the apparatus claims. Applicant should note that the primary reference combination clearly teach that which is recited by instant claims 13 and 14.

Sheinman (Figs. 1 and 2; col. 2, lines 41-42) teach forming a swirl imparting vane structure integrally with the bottom plate of a separator similar to that of the primary reference combination, by way of a stamping process. It should be noted that the stamping process inherently performs a slitting step immediately followed by a bending step to form the swirl vane structure. It would have been obvious for an artisan at the time of the invention, to provide the swirl vane structure, of the primary reference combination as applied to claims 3, 4, and 6-8 above, integrally with the bottom plate of the separator, in view of Sheinman, since such would facilitate easier assembly of the device over a structure wherein the bottom plate and the vanes were formed separately and then connected by welding, for example.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Bushey whose telephone number is 571 272-1153. The examiner can normally be reached on M-Th 6:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Scott Bushey  
Primary Examiner  
Art Unit 1724

csb  
9-13-06

  
9-13-06